

REMARKS

The Office has requirement restriction in the present application as follows:

Group I: Claims 1-7 and 35-40, drawn to an ink composition comprising a phosphonium compound;

Group II: Claims 8-13 and 41-46, drawn to an ink composition comprising an acetylene compound;

Group III: Claims 14-20 and 47-52, drawn to an ink composition comprising a cationic compound;

Group IV: Claims 21-27 and 53-58, drawn to an ink composition comprising a cationic color material;

Group V: Claims 28-34, drawn to an ink composition comprising a coloring material that is an inclusion compound;

Group VI: Claims 59-69, drawn to an ink composition comprising alkali metals; and

Group VII: Claims 70-220, drawn to a method of printing.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. M.P.E.P. § 803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Office has characterized the inventions of Groups I-VI as “unrelated”. In support of this allegation, the Office merely states that the “different inventions can be used separately”, without providing any supporting reasoning or examples. Applicants note that the M.P.E.P. describes unrelated inventions as, for example, “an article of apparel such as a

shoe, and a locomotive bearing” or “a process of painting a house and a process of boring a well.” M.P.E.P. § 806.04(A). Thus, unrelated inventions, as defined by the M.P.E.P., are inventions which are directed to *completely* different technical fields, and have no reasonable relationship with each other. In this regard, Applicants note that the inventions of Groups I-VI are all classified in Class 106. Applicants make no statement with regard to the patentable distinctness of the inventions of Groups I-VI, but respectfully submit that the Office has not shown how the inventions of these groups meet the standards of “unrelatedness” of M.P.E.P. § 806.04(A). Accordingly, Applicants respectfully submit that the Requirement for Restriction is improper, and request that it be withdrawn.

The Office has also characterized the inventions of Groups I-VI and Group VII as related as product and process of use. In support of this allegation, the Office merely states that the “different inventions can be used separately” without further arguments or examples. Thus, the Office has failed to adequately support the Requirement for Restriction.

Moreover, even if the Office is correct that the “different inventions can be used separately”, the Office has failed to show that such “separate use” is materially different from what is claimed. Accordingly, Applicants respectfully request that the Requirement for Restriction be withdrawn.

Furthermore, M.P.E.P. § 803 states:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants respectfully submit that the search of all of the claims would not impose a serious burden on the Office.

Finally, Applicants note that M.P.E.P. §821.04 states, “if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable

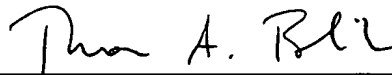
product claim will be rejoined." Applicants note that the claims of Group VII do "otherwise include all the limitations" of the elected product claims. Accordingly, Applicants respectfully submit that should the elected group be found allowable, the non-elected claims should be rejoined.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Requirement for Restriction. Applicants therefore request that the Requirement for Restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

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